DETAILED ACTION

Request for Continued Examination under 37 CFR 1.1141

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 11, 2011 has been entered.

Status of Claims

2. Claims 1-64, 68-70 and 75-97 have been cancelled during prosecution. Claims 65-67 and 71-74 are amended. Claims 98-111 are new. **Claims 65-67, 71-74 and 98-111 are pending**.

Response to Arguments

3. Applicant's arguments with respect to claim 65-67, 71-74 and 98-111 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections (Appropriate Corrections are Required)

4. **Claims 98-111** are objected to under 37 CFR 1.75(c) as being in improper form.

Claims 98 and 105 have been interpreted as being independent claims; however, the claims are written in a way in which they depend from the method of claim 65. An

independent claim should be written in a manner in which the claim stands alone (i.e. the claim should recite all applicable limitations).

Claims 99-104 (apparatus claims) and 106-111 (article of manufacture claims) have been interpreted as being in improper form as multiple dependent claims. These claims should also recite all applicable limitations.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 65-67, 74, 98-100, 104-107 and 111** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kossovsky et al., Pub. No. 2002/0004775 (hereinafter "Kossovsky"), in view of D'Loren, Pub. No. 2005/0021434 (hereinafter "D'Loren"), [which claims priority to application 09/851,895] and Llewelyn, Pub. No. 2002/0103744 (hereinafter "Llewelyn").

As per claim 65, Kossovsky et al. teaches a method comprising:

- selecting, via a processor, a plurality of companies to be included in an intellectual property (IP) index, in which each of the plurality of companies comprises an IP portfolio that comprise at least one patent (Abstract, ¶0010, ¶0079-0084, ¶0086, ¶0102-0104 and claim 12; which discusses a computer system for providing an index for market value of intellectual property assets belonging to a technology classification; storing information about companies having publicly traded securities in a database, wherein the companies operate predominantly within the technology classification; and the stored information includes patent(s));
- capturing, via the processor, market data relating to each of the plurality of companies (¶0035-0037 and ¶0093; which discusses downloading financial market data);
- generating, via the processor, an IP index that is based on the values of the IP portfolios of each company (Abstract, ¶0010, ¶0079-0084, ¶0086, ¶0102-0104 and claim 12; which discusses a computer system for providing an index for market value of intellectual property assets belonging to a technology classification; storing information about companies having publicly traded securities in a database, wherein the companies operate predominantly within the technology classification; and the stored information includes patent(s)).

Kossovsky does not explicitly teach the following limitations; however, D'Loren teaches the limitations:

- calculating, via the processor, a value of the IP portfolio for each of the plurality of companies by applying a set of criteria to the market data, in which the set of criteria (¶0019-0030; via an intellectual property valuation system that evaluates intangible assets of a business (i.e. an intellectual property portfolio of a business)) comprises:
- (i) determining a quantity of times that the at least one patent is cited by other patents (¶0022-0030; via information regarding how often the patent being evaluated has been cited as a reference for other patents); and
- (ii) determining a total quantity of patents issued to the company (¶0022-0030; discusses a list of patent numbers, which implicitly teaches the limitation).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by D'Loren within Kossovsky for the motivation to provide a method for securitizing intangible assets of a business, including the intellectual property, where the assets include trademarks and patents (¶0010).

Kossovsky teaches the construction of an IP index; however, Kossovsky does not explicitly teach the following limitations:

- receiving, from a remote device, a futures contract in the IP index (e.g. property index), in which the futures contract is based on the performance

of the IP index over a period of time, in which the remote device and the processor are in communication over a network (¶0035-0037, ¶0055-0056, ¶0126-0145 and ¶0199; and

- executing, via the processor, the futures contract at a future date.

Llewelyn teaches a method for futures trading in property. Llewelyn teaches generating an index from collected data related to properties; producing futures contracts for properties, which are based at least on the said index; and allowing the futures contracts to be traded on an exchange (¶0005-0010, ¶0061-0078 and claim 1).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Llewelyn within Kossovsky for the motivation to provide a method for generating a futures exchange in which the underlying securities or commodities are not fungible, such as when the underlying is property (¶0003-0004).

As per claims 66 and 67, Kossovsky teaches the following limitation:

- The method of claim 65, in which the act of selecting the plurality of companies comprises: determining that each of the plurality of companies belongs to a same industry (¶0045, ¶0084-0086 and Table 2; via technology sectors);
- The method of claim 65, in which the act of selecting the plurality of companies further comprises: determining that the IP portfolio of each of the plurality of companies comprises at least one patent related to a

particular subject matter (¶0045, ¶0084-0086 and Table 2; via technology sectors, for example Sector 17 - Apparel).

As per claim 74, Kossovsky teaches the following limitation:

- The method of claim 65, further comprising: determining, based on the IP index, a likelihood of failure of at least one of the plurality of companies (¶0126-0143; which discusses trading in both call and put options between market participants (companies or third-party hedgers) and the price of a put option being proportional to risk of failure of [a company's] technology).

As per claim 98, Kossovsky teaches an apparatus comprising:

- a processor; and a memory, in which the memory stores instructions (¶0035-0041; Claim 33; and Figs. 1, 2A, & 2B, which illustrate a computer system, and hardware/software structures).

The remaining limitations of claim 98 are substantially equivalent to the limitations of claim 65, and are therefore rejected on the same grounds.

The limitations of **claims 99, 100 and 104** are substantially equivalent to the limitations of claims 66, 67 and 74, respectively, and are therefore rejected on the same grounds.

As per claim 105, Kossovsky teaches an article of manufacture comprising:

- a storage medium, in which the storage medium stores instructions (¶0035-0041; Claim 33; and Figs. 1, 2A, & 2B, which illustrate a computer system, and hardware/software structures).

The remaining limitations of claim 105 are substantially equivalent to the limitations of claim 65, and are therefore rejected on the same grounds.

The limitations of **claims 106, 107 and 111** are substantially equivalent to the limitations of claims 66, 67 and 74, respectively, and are therefore rejected on the same grounds.

8. Claims 71-72, 101-102 and 108-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kossovsky, D'Loren and Llewelyn as applied to claims 65, 98 and 105 above, and further in view of Barney, Pub. No. 2004/0220842 (hereinafter "Barney").

As per claims 71 and 72, Kossovsky teaches patent term (¶0094), litigation and pending litigation (Fig. 18B); however, Kossovsky does not explicitly teach the following limitations:

- The method of claim 65, in which the set of criteria further comprises: (iv) determining a weighted average of ages of the at least one patent; and

- The method of claim 65, in which the set of criteria further comprises: (v) determining a quantity of successful litigations based on the at least one patent.

However, Barney teaches a statistical patent rating method for independently assessing the relative breadth ("B"), defensibility ("D") and commercial relevance ("R") of individual patent assets and other intangible intellectual property assets. The method includes study relevant characteristics from a sample of litigated patents to determine and measure those patent metrics (i.e. average age) that are predictive of a possible future event, such as a patent being litigated (Abstract, ¶0003, ¶0116-0117, ¶0120-0135 and Figs. 3-7).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned elements (i.e. average age and litigation) as taught by Barney within the combination of Kossovsky, D'Loren and Llewelyn for the motivation to provide a method for studying relevant characteristics of patents that can be used by patent valuation experts, investment advisors, economists and others to help guide future patent investment decisions, licensing programs, patent appraisals, tax valuations, transfer pricing, economic forecasting and planning, and even mediation and/or settlement of patent litigation lawsuits (Abstract).

The limitations of **claims 101 and 102** are substantially equivalent to the limitations of claims 71 and 72, respectively, and are therefore rejected on the same grounds.

The limitations of **claims 108 and 109** are substantially equivalent to the limitations of claims 71 and 72, respectively, and are therefore rejected on the same grounds.

9. Claims 73, 103 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kossovsky, D'Loren and Llewelyn as applied to claims 65, 98 and 105 above, and further in view of Poltorak, Pat. No. 7,792,728 (hereinafter "Poltorak").

As per claim 73, Kossovsky does not explicitly teach the following limitation; however, Poltorak teaches the limitation:

- The method of claim 65, in which the set of criteria further comprises: (vi) determining an amount of licensing revenue generated by the at least one patent (Abstract; col.1, lines 14-21; col.6, line 3 thru col.7, line 47; and Figs. 2A, 5 and 7).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned elements (i.e. average age and litigation) as taught by Poltorak within Kossovsky for the motivation to provide a method for intellectual property valuation methods that is based on the attributes of the property valued and produces analytical results reflective of real world risks, opportunities, and outcomes (col.2, lines 45-50).

The limitations of **claims 103 and 110** are substantially equivalent to the limitation of claim 73, and are therefore rejected on the same grounds.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GREGORY JOHNSON/
Examiner, Art Unit 3691